

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#4
411
7/12/02

Applicant: Alex Bellehumeur

Filing Date: January 24, 2002

Reissue Application Serial No.: 10/057,671

Title: PUCK FOR USE ON A
NON-ICE SURFACE

Commissioner of Patents
and Trademarks
Washington D.C. 20231

)
) **RE-ISSUE LITIGATION**
)
) Attention:
) Group Art Unit 3711
) Examiner: Raleigh Chiu
) Patents

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Dear Sir:

PROTEST UNDER 37 CFR 1.291(a)

Mr. Steven L. Permut (Registration No. #28,388), on behalf of an unnamed client, files the present protest for the above-identified at-issue application in accordance with 37 CFR 1.291(a). Mr. Bellehumeur has sued several entities including Tsunami Hockey, LLC, Mr. Carl Lekavich & Ideal Design Sports, Inc. for infringement of his U.S. Patent 5,597,161. During these litigation matters, it has been revealed through depositions and other documents in evidence that no inadvertent mistake or error occurred that provides Mr. Bellehumeur the right to a reissue of the 5,597,161 patent. One litigation matter, Bellehumeur v. Tsunami Hockey, LLC is currently pending trial. Another litigation matter, Bellehumeur v. Carl Lekavich & Ideal Design Sports is presently on appeal to the Federal Circuit.

The protest is based on several basic reasons. Mr. Bellehumeur and his attorney have played fast and loose with the United States Patent and Trademark Office for

many years and thus has derived a factually complicated situation. However, we can distill the issues based on the complication fact patterns to several independent important reasons.

Firstly, the submission of a Terminal Disclaimer was not an error to the specification or claims subject to the 35 USC §251 provision. Secondly, the reissue application was not filed diligently after the error was discovered and placed in front of Mr. Bellehumeur. There is also an improper enlargement of the scope of protection after the two year period. Thirdly, the reissue application and the declaration are devoid as to asking for a correction to the specification, drawings or claims. Furthermore, no corrections to the ownership, inventorship or terminal disclaimer is evident in the reissue application. Fourth, the reissue application also is not signed by either all the listed inventors or all the present owners of the application. Mr. Bellehumeur is signing on behalf of his wife without proper power of attorney or authority submitted by Mr. Bellehumeur. The reissue application then again adds Mr. Nehmens and Mr. Haarlammert as inventors, which further confuses the issue as to who is the true inventor. Mr. Bellehumeur's silence as to the change of ownership violates his duty of candor under Rule 56. Lastly, the wrong inventorship is listed in the reissue application and that Mr. Bellehumeur is not the inventor of the claims under 35 USCA §102(f).

TERMINAL DISCLAIMER

The deliberate filing of a terminal disclaimer to overcome a double patenting rejection is not an error to the specification or claims under 35 USC §251. The statute specifically states:

“the patent is ... wholly or partly inoperative or invalid, by reason of a [1] defective specification or [2] drawing, or [3] by reason of the patentee claiming more or less than he had a right to claim.”
(*numbers added for emphasis*)

Mr. Bellehumeur has not indicated where the defect is in the either the [1] specification, [2] drawings or [3] in the claims. Not all errors are correctable by a reissue application. Fore example, restriction requirements filing of a divisional application are not correctable by reissue. See In re Orita 193 USPQ 145 (C.C.P.A. 1977), In re Watkinson 14 USPQ 2nd 1407 (Fed. Cir. 1990). In fact, a case on point, Ex parte Anthony et al. 230 USPQ 467 (PTOBA, 1982, released 1986) (Exhibit A) sets forth that a deliberate filing of a terminal disclaimer does not constitute “error” where it was to overcome a double patenting rejection.

“the terminal disclaimer which is now attempted to be nullified was a substantive significance which had a direct bearing in the issuance of the original patent,. Nor is the reissue being sought to correct a defect in the specification or drawing or because the patentee is claiming more or less than he had a right to claim in the patent.” Ex parte Anthony supra at p. 470.

Such is the same with the present case and as such a reissue application is not the proper remedy for applicant.

NO SHOWING OF DILIGENCE

None of the declarations provided the needed showing of diligence. The ‘161 patent issued on January 28, 1997 and a period of almost exactly 5 years passed before the present reissue application was filed. Under MPEP 1403, this is well outside the 2 year period from the issuance of the ‘161 patent where a showing of diligence is not required.

While the final summary judgment was issued on November 28, 2001, there is no excuse for the delay from January 28, 1997. While Mr. Averill states he did not know of the existence of the assignment of U.S. Patent 5,275,410 at the time of the filing of the terminal disclaimer. He however, never mentions when he became aware of the assignment. Secondly, even if Mr. Averill did not become aware of the discrepancy, the issue is when Mr. Bellehumeur became aware of the discrepancy. I suggest that Mr. Bellehumeur became aware of it as soon as Mr. Averill sent a confirming copy of the terminal disclaimer to his client shortly after sending it to the United States Patent and Trademark Office.

In spite of this, Mr. Bellehumeur did nothing to correct this obvious blatantly incorrect terminal disclaimer for a 5 year period. Diligence is still required even for a narrowing reissue application. See General Radio Company v. Allen B. DuMont Laboratories 129 F.2d 608 (3rd Circ. 1942).

While Mr. Averill may not have known of the assignment of the '410 patents, Mr. Bellehumeur definitely knew of this assignment due to his signature thereon that was dated on February 8, 1996, probably after he received notice that Mr. Averill signed the Terminal Disclaimer.

In any event, no showing of diligence from the time the error was discovered is made in any of the submitted papers for reissue.

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IMPROPER ENLARGEMENT OF SCOPE OF PATENT AFTER TWO YEARS

Furthermore, by eliminating the terminal disclaimer it is argued that he is broadening the protection by increasing the duration of the patent. Therefore, the vertical scope is improperly enlarged. See Ex parte Anthony *supra* P.470.

NO CORRECTION OF OWNERSHIP

Mr. Averill makes short shrift as to who the owners are of the '410 patent and the '161 patent. He attempts to quickly resolve the issue by referring to MPEP §306 and conclusorily states that since the assignment which was signed and dated on February 8, 1996 has an "effective date" of January 1, 1996 this is prior to the filing of the U.S. application 08/590,870. However Mr. Averill is leaving out several important facts. The parent cases of 08/590,870 were not mentioned. The continuation application 08/150,420 filed on November 10, 1993 and the application 08/303,589 filed on September 9, 1994 and still pending as of January 1, 1996 were not assigned. As such, the recording section of the United States Patent and Trademark Office made a mistake to apply the assignment dated February 8, 1996 (effective January 1, 1996) to the then existing application and its later continuation 08/590,870.

It is my contention that there is still a split of ownership with Mr. & Mrs. Bellehumeur owning the '410 patent and only Mr. Bellehumeur owning the '161 patent. Instead of simply correcting this assignment claim, Mr. Bellehumeur is asking the United States Patent and Trademark Office for a "blessing" that the terminal disclaimer somehow was incorrectly

signed and should be ignored without correcting anything in the reissue application or correcting the ownership ambiguity. This is an improper request for a reissue.

VIOLATION OF DUTY OF CANDOR UNDER RULE 56

Mr. Bellehumeur's lack of disclosure of this assignment to the Examiner before the issuance of the '161 application is believed to be a violation of his duty to disclose under Rule 56. Rule 56 applies to more material than just a disclosure of prior art. After multiple previous rejections for double patenting, Mr. Bellehumeur files a terminal disclaimer and then on February 8, 1996 assigns the '410 application over to another entity. He then does not disclose it to the Examiner even though recorded on April 3, 1996. This change of ownership was material to the issuance of a second patent under the rules of double patenting.

Mr. Bellehumeur had knowledge of the ineffective January 1996 terminal disclaimer. He then changed ownership and still did not tell his attorney in spite of the declaration signed years earlier that states he is aware of his duty of candor under Rule 56. Such non-disclosure is not a mere error and cannot be corrected by his attorney's statements which tell only part of the truth and not the whole truth.

NO PROPERLY SIGNED OATH

The application must be signed by all the inventors except when all the owners sign when the application does not seek to enlarge the scope of the claims. See Rule 172.

While the present application confusingly lists Mr. Nehmens and Mr. Haarlammert as inventors, they did not submit any signed declaration. As far as ownership, Mr. Alex Bellehumeur signed on behalf of his wife. This is not in accordance with Rule 1.172 or 3.73. furthermore, there is no statement that he is authorized to act on behalf of his wife. See 3.73(b) 2 (i). Furthermore, Mr. Edgar Averill's statement under 3.73 (b) does not support authorization of Mr. Bellehumeur to sign on behalf of his wife. On the face of the documents, he is not representing Mrs. Linda Dyer Bellehumeur.

WRONG INVENTORSHIP

It is also noted that Mr. Bellehumeur, Mr. Nehmens and Mr. Haarlammert were listed as inventors or patentees in the reissue application. However, Mr. Bellehumeur has sworn in his declaration under Rule 37 CFR 1.132 filed on January 11, 1996 that he was "the inventor of the subject matter of the 08/303,589 patent application [now U.S. Patent 5,597,161] (Exhibit B). He further declared he was "the inventor" in his declaration filed October 6, 2000 in a previous re-examination request (Exhibit C). However, he now lists all three as co-inventors or patentees in the present application.

During litigation, serious evidence arose that Mr. Bellehumeur was not the inventor of the concept of using a different plastic or polymeric material as set forth in all the claims of the '161 patent. Please see Mr. Dan Kotler's declaration (Exhibit D) filed in one of Mr. Bellehumeur's litigation matters, Bellehumeur v. Tsuanmi Hockey, LLC where he declares that Mr. Bellehumeur came to him with a prototype of a hockey puck made with a

plastic body and with metal runners. It was Mr. Kotler who suggested changing the metal runners to a different plastic.

This declaration is corroborated by one of the co-inventor's, Mr. Haarlammert who states that the drawings in the '410 patent are what he and John Nehmens designed without Mr. Bellehumeur. See deposition papers as Exhibit E.

Mr. Nehmens also corroborates on P. 52 of his deposition that the first runners were made of stainless steel spinners and brass spinners, and threaded metal screws, p. 126, p. 128 and p. 140 where it was then given to Mr. Kotler. See deposition papers as Exhibit F.

Also enclosed are declarations from Mr. King and Mr. Pona which also corroborates doubts as to Mr. Bellehumeur's contribution under §102(f) (Exhibit G and H). In fact, if you carefully read Mr. Bellehumeur's Rule 132 declaration, (Exhibit B) he himself omits that he came up with a "plastic" or "polymer" runner. Taking all the documents together, it is clear that he invented a plastic puck with a metal runner but not a plastic puck with runners of a different plastic or polymer material. However, his claims are directed to such plastic or polymer runners which he carefully avoids declaring that he invented in his Rule 132 declaration (Exhibit B).

CONCLUSION

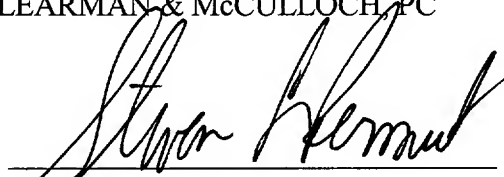
Mr. Bellehumeur has stretched the rules of the United States Patent and Trademark Office in his favor for many years. He has tried to avoid filing the terminal disclaimer over multiple rejections of double patenting. He has signed assignment documents which on their face assigns only the '410 patent and do not assign the '161 U.S. Patent.

He was aware of the changed ownership, was aware of his attorney filing the terminal disclaimer, was aware of his duty of candor and has sued many people over the years. He only now has filed a request for reissue after 5 years with not apparent correction of any error in the specification drawing or claims. As such this application for reissue should be denied.

If it is determined that any fees are due with this submission, the Commissioner is hereby authorized and respectfully requested to charge such fee to our deposit account No. 50-0852.

Respectfully submitted,

REISING, ETHINGTON, BARNES, KISSELLE,
LEARMAN & McCULLOCH, PC



Steven L. Permut
Reg. No. 28,388
P.O. Box 4390
Troy, Michigan 48099
(248) 689-3500

Date: June 13, 2002

10057671-000402

PROOF OF SERVICE

I hereby certify that a copy of the foregoing PROTEST UNDER 37 CFR 1.291(a) was served by first class mail, postage pre-paid, on counsel of record for Alex Bellehumeur at the following addressee on June 13, 2002:

Edgar W. Averill, Jr., Esq.
AVERILL & VARN
8244 Painter Avenue
Whittier, CA 90602


Dawn Large